17

FILED
APR 27 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

MORRIS KIRSCHSTEIN,
CLIFFORD H. BELL,
of Counsel for Respondents.

INDEX

PAGE

Statement 1

I This Court has already definitely refused to grant *certiorari* to review the identical question in *Macbeth-Evans Glass Company* v. *General Electric Company* (246 U. S. 659), No. 821 October Term, 1917) 3

II The decision of the Court of Appeals in the present case is in harmony with the decisions of this Court, the Circuit Courts of Appeals and the District Courts. No novel question of patent law is presented 4

TABLE OF CASES CITED

Allinson Mfg. Co. v. Ideal Filter Co., 21 Fed. (2d) 22 (CCA 8) 7

Egbert v. Lippmann, 104 U. S. 333 ..... 6, 8, 9

Electric Storage Battery Co. v. Shimadzu, 307 U. S. 5 .. 9

Elizabeth v. Pavement Co., 97 U. S. 126 9

Grasselli Chemical Co. v. National Aniline Co., 26 Fed. (2d) 305 (CCA 2) 7

Hall v. Macneale, 107 U. S. 90 ..... 7, 9

Kendall v. Winsor, 21 Howard 322 10

Macbeth-Evans Glass Company v. General Electric Company, 246 U. S. 659 ..... 3, 8

Macbeth-Evans Glass Company v. General Electric Company, 246 Fed. 695 (CCA 6) 8

Macbeth-Evans Glass Company v. General Electric Company, 231 Fed. 183 (D. C.) 8

Pennock and Sellers v. Dialogue, 2 Peters 1 ..... 4, 5, 6, 8

Woodbridge v. United States, 263 U. S. 50 ..... 6, 9, 10

STATUTE CITED

35 U. S. Code Sec. 31 (R. S. 4886) 5

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

The petition does not present a case of conflict between Circuit Courts of Appeals; nor is it predicated upon a question of public interest. No novel question of patent law is involved.

Statement

This case is merely an ordinary patent suit in which petitioner charges respondents with infringement of the Meduna Reissue patent No. 22,397. The District Court held the patent valid and infringed. The Court of Appeals for the Second Circuit reversed, holding the patent invalid on the ground that the inventor had forfeited his right to a patent because he had made public use of the invention for profit for more than one year prior to filing of his application. This statutory bar had been pleaded and overruled in the District Court. The Circuit Court of Appeals found the bar to have been established. The

defense of lack of invention had also been pleaded and overruled in the District Court. This defense too was presented for review to the Circuit Court of Appeals but that Court did not pass on that issue.

The patent is for a process of building up worn metal parts of a machine by spraying the worn part with molten metal. This is known as "metallizing" and the process as thus generally described is old. In accordance with the invention the part to be sprayed, for example, a crank shaft of an automobile, is first roughened by electrically depositing on its surface a rough layer of metal. This layer serves as the anchoring or bonding means for receiving and holding the molten metal spray which is applied to the surface by means of a spray gun in similar fashion to the spraying of paint or other coatings on surfaces. The spraying proceeds until a sufficiently thick coating has been applied to bring the worn metal part back to its normal diameter. The invention was perfected in April 1940. The inventor chose not to file an application for patent at that time. *Instead he proceeded to immediately employ the process in secrecy for profit.* He advertised his new process to the trade, solicited work through a salesman, and from *April 1940 to August 6, 1942,* the filing date of his application, repaired all sorts of metal parts for the trade as a regular business, and charged each customer for the work. The District Court found that although the operations themselves were carried on in secrecy, the inventor's main purpose in his use of the process for more than one year prior to the filing of his application, was *commercial* and that any experimental purpose was subordinate only. These findings were held to be fully supported by the testimony and accepted by the Circuit Court of Appeals (283 C).* (See findings 10, 11, 12, at 951-952 B).

---

* We follow the same form of reference to the transcript of record as that adopted by petitioner, namely, by page number followed by the letter designating the volume, A, B or C.

The statutory year preceding the application date expired on August 6, 1941. Every metal part that the inventor built up with his new process during the year and four months preceding that date and turned over to the owners thereof, i. e., members of the public, contained the process of the patent. It contained the "thing invented." Each metal part had the electrically deposited bonding layer on which the metal spray had been applied. The Circuit Court of Appeals held under these facts, that the invention had been in public use and/or on sale by the inventor for more than one year prior to the filing of the application and that therefore the forfeiture worked by the statute applied.

The District Court had held otherwise relying upon the finding that the process had been performed secretly and was not detectable from the article treated thereby. Its decision was contrary to the law as established by this Court and the Court of Appeals necessarily had to reverse.

The question here sought to be reviewed is not a novel one. It has been decided adversely to petitioner over and over again by this Court and the Circuit Courts of Appeals.

I

This Court has already definitely refused to grant *certiorari* to review the identical question in *Macbeth-Evans Glass Company* v. *General Electric Company* (246 U. S. 659) (No. 821 October Term, 1917).

In the *Macbeth-Evans* case the petition for the writ (pp. 2-3) stated the "question involved" in the following language:

> "The question is, in view of the foregoing provisions of the Patent Statutes, can an inventor obtain Letters

Patent on a *method* of making glassware, which invention (*the method*) he practiced *in secret,* but not in *public,* for more than two years*, but the *product* of which he sold to the public for more than two years before he filed his application?"

II

The decision of the Court of Appeals in the present case is in harmony with the decisions of this Court, the Circuit Courts of Appeals and the District Courts. No novel question of patent law is presented.

In essense *an old question has been decided according to the highest precedents.*

In this Court the leading case is *Pennock and Sellers* v. *Dialogue,* 2 Peters 1. In that case this Court laid down the underlying principle that: "If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; * * * and make, and sell his invention publicly, and thus gather the whole profits of it * * * and he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries" (p. 19). This was perhaps the first pronouncement by this Court of the underlying reason for the provision in all the patent statutes, from the first enacted to the present, that the invention must not have been known, used, or sold for a prescribed period prior to the application date.

What Congress sought to accomplish at all times was to prevent a delay of the disclosure by the inventor with a

---

* The present statute reads "one year."

consequent extension of his monopoly; and therefore each patent statute has provided for a forfeiture of the right to a patent where the inventor uses his invention competitively for the period beyond that given him in the Statute. The Statute now in force and here applicable states the condition to be that the invention shall not have been "in public use or on sale in this country for more than one year prior to his application." (35 U. S. Code Sec. 31 [R. S. 4886]). An inventor who elects to continue to use his invention competitively for more than that period has elected to forfeit his right to a patent.

It is not material that his operations were carried on in secrecy. If in fact, as was the case here, articles containing the invention or made by the invention were publicly used and sold, then upon the rationale of the *Pennock* v. *Dialogue* decision it should make no difference at all that the patent is for a process and that the process is not detectable from the article to which it has been applied and which has been sold to the public. To hold otherwise would be to discriminate between processes which may be detected and those which may not and to unjustly make an inventor who happened to invent a process which is undetectable, a favorite of the law. Why should the fortuitous circumstance of non-detectability give him any better standing before the law than an inventor who invents a process which is detectable?

Pennock v. *Dialogue* involved a process patent. The patent there was, as Mr. Justice Story stated, "for a new and useful improvement in the *art* of making leather tubes or hose for conveying air, water or other fluids." (p. 14) (italics supplied). And on page 3 the report states that the suit had been instituted "for an infringement of a patent right for 'an improvement in the art of making tubes or hose for conveying air, water and other fluids.' The invention claimed by the patentees was in the *mode of making* the hose so that the parts so joined

together would be tight and as capable of resisting the pressure as any other part of the machine" (italics supplied).

There is no foundation whatsoever for petitioner's contention (petitioner's brief, p. 25) that the patent was not for a process but for a "hose structure". *Pennock* v. *Dialogue*, as Judge Learned Hand correctly stated, was clearly a case on all fours with the case at bar in that it was the hose itself which was publicly sold and the patented process was embodied in the hose, similarly to the situation here.

Pennock v. *Dialogue* has been uniformly followed by this Court and its doctrine reaffirmed and expanded in cases as they arose in connection with the later patent statutes. See *Egbert* v. *Lippmann*, 104 U. S. 333; *Hall* v. *Macneale*, 107 U. S. 90.

The doctrine was reiterated emphatically, quite recently in *Woodbridge* v. *United States*, 263 U. S. 50, in the following language:

> "Any practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date of the actual invention, the beginning of the term of his monopoly, and thus puts off the free public enjoyment of the useful invention, is an evasion of the statute and defeats its benevolent aim" (p. 56).

That the Second Circuit Court of Appeals in the case at bar followed the law as laid down by this Court is in itself a complete answer to the only ground upon which the present petition is based.

However, the decision here questioned is also in harmony with decisions of other Circuit Courts of Appeal who have likewise clearly understood and carefully followed *Pennock* v. *Dialogue* and the other decisions of

this Court above noted. See *Allinson Mfg. Co.* v. *Ideal Filter Co.*, 21 Fed. (2d) 22 (CCA8) and *Grasselli Chemical Co.* v. *National Aniline Co.*, 26 Fed. (2d) 305 (CCA2).

Allinson v. *Ideal* did not turn only upon abandonment of the right to a patent as petitioner in its brief, page 28, appears to contend. On the contrary, the Circuit Court of Appeals for the Eighth Circuit also specifically passed upon the issue of public use for more than two years—the then statute. There it was the patented apparatus that was operated in secrecy. The product of the use of the apparatus, namely refined gasoline, is what reached the public. The Court said:

> "He used his apparatus in competitive trade and reaped profits from his customers over and above what he would have received had he contained to use the still or other old methods. It was the intended use and only use to which and for which it was later manufactured and sold. These facts, we think, clearly constituted a public use within the purpose and meaning of the statute" (p. 27).

And in the *Grasselli* case the patent was for a process which had been kept secret but the product had been sold upon the market for more than two years. The Second Circuit Court of Appeals by Judge Learned Hand said:

> "The proof is ample that it was used for vulcanization in large quantities before December 31, 1913, in the factory of the Diamond Rubber Company and that tires were made of the product and sold. This was the only kind of use possible and it was public. In Egbert v. Lippmann, 104 U. S. 333, 26 L. Ed. 755, and Hall v. McNeale, 107 U. S. 90, 2 S. Ct. 73, 27 L. Ed. 367, it was held that a use is public though the invention cannot be learned unless the embodiment of it is destroyed. If the accelerator could have been discovered by dissolving the product into its

constitutents, these cases would directly apply. However, this was not the case before 1914 and there was no way of learning from the product either its composition *or the process by which it had been made.* Such was the case also in Macbeth Evans Glass Co. v. General Electric Co. (D. C. Ohio), 231 F. 183, and it seems to us that the distinction cannot serve to prevent anticipation. It is quite true that the art is not enriched by such a use, but then it is not enriched even if the invention can be learned by destroying the embodiment. The fact that a curious person might disentangle it does not mean that any one will do so, and the discovery remains inaccessible for practical purposes. It might have been proper theoretically to exclude such uses, but we think that the statute has cut the knot. *Once the invention has been embodied in goods which are put in public use it becomes impossible for a later inventor to secure a patent''* (pp. 308-9). (Italics supplied.)

In *Macbeth-Evans etc. Co.* v. *General Electric Co.,* 231 Fed. 183, a process for the manufacture of illuminating glass had been operated in secrecy and the glass produced by the process sold to the public for more than two years prior to the filing of the patent application. The process was in noways disclosed by the glass. The District Court, with special reference to Mr. Justice Story's decision in *Pennock* v. *Dialogue,* and relying also on *Egbert* v. *Lippman* and *Hall* v. *Macneale,* held that that was a public use of the invention such as to work the forfeiture of the statute and said:

> "No case has been cited to the Court where a patent has been held valid after a long commercial but secret use of it, upon the ground that such a use was not a public one within the meaning of the patent statutes" (p. 188).

True, the Sixth Circuit Court of Appeals in 246 Fed. 695, affirmed upon the ground of abandonment and therefore found it unnecessary to pass upon this holding of the lower court that there was a public use. That does not vitiate this holding. Nor could the Sixth Circuit Court of Appeals have done so because that would have been in flagrant disregard of the decisions of this Court already above noted. This is evidenced by the fact that the Court denied *certiorari* when the very question here sought to be reviewed was presented in the *Macbeth-Evans* case (*ante*, p. 3) and by the repeated approval of that case by this Court. See *Woodbridge* v. *U. S.*, 263 U. S. 50, 59; *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5, 15.

Petitioner has misconstrued the meaning of the words "public use" in the Statute. The interpretation given by this Court to these words avoids the legal anamoly which would result from exempting processes used in secrecy for profit. The word "public" does not mean exposed to the public. Thus in *Elizabeth* v. *Pavement Co.*, 97 U. S. 126, the pavement was, of course, exposed to the public. But the use was experimental and not for a profit and that saved the patent there from the very condemnation of this Court in the following language:

> "Any attempt to use it for profit, and not by way of experiment, for a longer period than two years before the application would deprive the inventor of his right to a patent" (p. 137).

On the other hand, in *Egbert* v. *Lippmann*, 104 U. S. 333, where the statutory "public use" was found, the patented steel corset stay was placed in a single corset which was worn by a member of the public and certainly was not exposed to public view. Likewise, in *Hall* v. *Macneale*, 107 U. S. 90, the patented bolts used in a safe construction were within a wall of the safe "hidden from view, after the safes were completed" (p. 97). Thus public use

obviously does not connote exposure to the public. Secrecy may be considered only as an evidentiary factor in connection with experimental use. It cannot save an invention against a commercial competitive use.

Kendall v. *Winsor*, 21 Howard 322, is not in conflict with the decision of the Circuit Court of Appeals here. *Kendall* v. *Winsor* merely held that the instructions (pp. 326-327) given by the Trial Judge to the jury were correct and "in strict conformity" (p. 331) with *Pennock* v. *Dialogue*.

Petitioner's effort to distinguish the authorities relied on by insisting on intent to abandon was succinctly answered by this Court in *Woodbridge* v. *United States*, *supra*, in the following language:

> "It is urged that such authorities have no application because intent to abandon cannot be inferred from delay in this case. That is true; but our conclusion rests not on neglect and intention to give up the patent, but on a deliberate and unlawful purpose to postpone the term of the patent the inventor always intended to secure" (263 U. S. at p. 59).

It is submitted, therefore that the petition for the writ of *certiorari* should be denied.

Respectfully submitted,

MORRIS KIRSCHSTEIN,
CLIFFORD H. BELL,
of Counsel for Respondents.